

REMARKS

The Office Action dated November 18, 2003, has been received and carefully considered. In this response, the specification, claims 1-25 and figures 3, 7, 10, 12A, 12B and 17 have been amended. Entry of the amendments to the specification, claims and figures is respectfully requested. Reconsideration of the outstanding objections and rejections in the present application is also respectfully requested based on the following remarks.

I. AMENDMENTS TO THE SPECIFICATION

The amendments to the specification improve its form and readability and correct various typographical errors. Support for the amendments to the specification can be found in the specification and figures as originally filed. No new matter is introduced by the amendments to the specification.

II. AMENDMENTS TO FIGURES 3, 7, 10, 12A, 12B, 17 and 18A-19C

Figures 3, 7, 10, 12A, 12B, 17 and 18A-19C have been amended to improve to improve their form and to address various objections presented by the Draftsperson. Support for the amendments to the figures may be found in the specification and figures as originally filed. No new matter is introduced by these amendments.

Figure 3 has been amended to change reference numbers S100-

S106 to reference numbers 200-206, respectively. The text associated with figure element 204 has been changed to recite the term "Huffman" instead of "Human".

Figures 7 and 10 have been amended to improve the figure legend.

Figure 12A has been amended to change reference numbers D10-D22 to reference numbers 510A/510B and 512-522, respectively.

Figure 12B has been amended to change reference numbers D24-D28 to reference numbers 524-528.

Figure 17 has been amended to improve the figure legend and to include reference numbers 702 and 704. The specification has been amended to reflect the addition of these reference numbers.

Figures 18A-19C have been amended by submitting black and white copies to replace the originally filed color drawings.

III. AMENDMENTS TO CLAIMS 1-25

Claims 1-25 have been amended as indicated in Appendix C. To clarify the record, these amendments were made solely to improve the form, readability, clarity and consistency of the claims, and were not made to distinguish the claimed subject matter over the applied references. Support for the amendments to claims 1-25 can be found in the specification and claims as

originally filed. No new matter is introduced by these amendments.

IV. THE OBJECTION TO FIGURES 18A-19C

On the Notice of Draftsperson's Patent Drawing Review attached to the Office Action, Figures 18A-19C were objected to under 37 CFR 1.84(a) as being color drawings submitted prior to the grant of a petition to accept color drawings in the present invention. Rather than file a petition to accept color drawings, the Applicants submit herewith black and white photocopies to replace the color drawings originally filed and respectfully request entry thereof.

In view of the foregoing, it is respectfully requested that the aforementioned objection to Figures 18A-19C be withdrawn.

V. THE OBJECTION TO FIGURES 7, 10, AND 17

On the Notice of Draftsperson's Patent Drawing Review attached to the Office Action, Figures 7, 10 and 17 were objected to under 37 CFR 1.84(p) as having poor figure legends. Figure 17 was also objected to as having numbers and reference characters that are not plain and legible.

The replacement figures submitted in Appendix B address these objections by correcting the figure legends of Figures 7, 10 and 17 and by inserting reference numbers in Figure 17. No new matter is introduced by the amendments to Figures 7, 10 and

17. Accordingly, it is respectfully requested that the aforementioned objection to Figures 7, 10 and 17 be withdrawn.

VI. IMPROPER USE OF U.S. PATENT NO. 6,594,394 AS PRIOR ART

On pages 2-12 of the Office Action, the Examiner cited U.S. Patent No. 6,594,394 ("Stromberg") in support of the rejections of claims 1-24 under 35 U.S.C. § 103(a). Applicants respectfully submit that Stromberg does not qualify as prior art with respect to the present application.

Stromberg does not qualify as prior art under 35 U.S.C. § 102(a), (b), (c), (d), (f), or (g) because: 1) Stromberg was not published before the present invention was invented by the Applicants; 2) Stromberg was not published at least a year before the effective filing date of the present application; 3) the Applicants have not abandoned the invention; 4) no application for the present invention was filed more than twelve months before the present application; 5) the Applicants invented the subject matter sought to be patented; and 6) no interference has been conducted.

With regard to 35 U.S.C. § 102(e), the MPEP states:

[p]atents issued directly, or indirectly, from international applications filed before November 19, 2000 may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. **Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later filed U.S. continuing**

application that claimed the benefit of the international application.

MPEP § 706.02(a) (Rev. 1, Feb. 2003) (emphasis added).

Correspondingly, the version of 35 U.S.C. § 102(e) in effect at the time of the filing date of Stromberg states that a person shall be entitled to a patent unless

the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the application for patent, **or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant of patent.**

35 U.S.C.S. § 102(e) (1999) (former version) (emphasis added).

Stromberg is a U.S. patent granted from a 35 U.S.C. § 371 application filed Jul. 22, 1999 (i.e., before November 29, 2000), so the former version of 35 U.S.C. § 102(e) applies to Stromberg. Accordingly, the 35 U.S.C. § 102(e) date for Stromberg is the date that the Stromberg international application fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) (i.e., the "§ 371(c)(1), (2), (4) date"), which was March 20, 2000.

The present application enjoys the benefit of U.S. Provisional Application No. 60/171,509, filed December 22, 1999. This provisional application discloses and enables the subject matter of claims 1-25. Thus, because the effective filing date of the present application precedes the 35 U.S.C. 102(e) date of

Stromberg, Stromberg does not qualify as prior art under 35 U.S.C. § 102(e) with respect to the present application.

Accordingly, because Stromberg fails to qualify as an applicable reference under any of the provisions of 35 U.S.C. § 102, the Applicants respectfully submit that the Examiner erred in using Stromberg in support of the obviousness rejections.

VII. THE OBVIOUSNESS REJECTION OF CLAIMS 1-3, 9-12, 16-19 AND 21-24

On page 2 of the Office Action, claims 1-3, 9-12, 16-19 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shapiro (U.S. Patent No. 5,315,670) in view of Stromberg, et al. (U.S. Patent No. 6,594,394). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner alleges that Shapiro teaches most of the limitations recited in claims 1-3, 9-12, 16-19 and 21-24.

However, with respect to independent claims 1, 9 and 16, the Examiner expressly concedes that Shapiro fails to disclose the limitation of encoding of a low-low pass subband of level n using a low frequency packing algorithm. (Office Action, p. 3). Likewise, with respect to independent claims 10, 17, and 21, the Examiner expressly concedes that Shapiro fails to disclose the limitation of a two-dimensional discrete wavelet filter for transforming the input data into a plurality of coefficients forming a first level, intermediate levels and a low-low subband of a highest level.

In an attempt to establish the obviousness of the limitations not disclosed by Shapiro, the Examiner alleges that Stromberg discloses these limitations and thus it would be obvious for a person of ordinary skill in the art to combine the teachings of Shapiro and Stromberg to arrive at the present invention as claimed in claims 1-3, 9-12, 16-19 and 21-24.

Regardless of whether the combination of Shapiro and Stromberg discloses what is alleged or whether it would be appropriate to combine the teachings of Shapiro and Stromberg, Stromberg, as discussed above, does not qualify as prior art with respect to the present application and therefore is inappropriately used by the Examiner in support of this obviousness rejection under 35 U.S.C. § 103(a). As admitted by the Examiner, Shapiro fails to disclose every limitation recited

in independent claims 1, 9, 10, 16, 17 and 21. Moreover, none or the remaining applicable references disclose, teach, or suggest, alone or in combination with Shapiro, each and every limitation recited in independent claims 1, 9, 10, 16, 17 and 21.

Claims 2, 3, 11, 12, 18 and 22-24 depend from one of independent claims 1, 9, 10, 16, 17 or 21 and therefore are allowable at least by virtue of their dependency on the above-identified independent claims.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 1-3, 9-12, 16-19 and 21-24 is improper at this time and the withdrawal of such rejection is respectfully requested.

VIII. THE OBVIOUSNESS REJECTION OF CLAIMS 4-8, 13-15, 20 AND 23

On page 7 of the Office Action, claims 4-8, 13-15, 20 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shapiro in view of Stromberg as applied to claims 1, 10, and 17 (see above) and further in view of Divakaran (U.S. Patent No. 6,618,507). This rejection is hereby respectfully traversed.

The Examiner alleges that the combination of Shapiro and Stromberg teaches the limitations of the claims from which claims 4-8, 13-25, 20 and 23 depend and concedes that the

combination of Shapiro and Stromberg fails to disclose one or more of the limitations additionally recited by the dependent claims 4-8, 13-25, 20 and 23. In an attempt to establish the obviousness of the limitations not disclosed by the combination of Shapiro and Stromberg, the Examiner alleges that Divakaran discloses these limitations and it thus would be obvious for a person of ordinary skill in the art to combine the teachings of Shapiro, Stromberg and Divakaran to arrive at the present invention as claimed in claims 4-8, 13-15, 20 and 23.

Regardless of whether Divakaran discloses that which is alleged, the Examiner inappropriately used Stromberg in support of this obviousness rejection because Stromberg does not qualify as prior art with respect to the present application, as discussed above. Also as discussed above, none of the applicable references disclose, teach, or suggest, alone or in combination, each and every limitation recited in independent claims 1, 10 and 17. The applicable references therefore fail to disclose, teach or suggest, alone or in combination, each and every limitation of claims 4-8, 13-25, 20 and 23 at least by virtue of their dependency on the above-identified independent claims.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 4-8, 13-15,

20 and 23 is improper at this time and the withdrawal of such rejection is respectfully requested.

IX. FAILURE TO PROVIDE A BASIS FOR THE REJECTION OF CLAIM 25

The Office Action Summary indicates that the Examiner rejected claims 1-25, but the body of the Office Action provides a basis of rejection only for claims 1-24. No basis is set forth for rejecting claim 25. Regardless, claim 25 depends from claim 24, which depends from independent claim 21, and, as discussed above, none of the applicable references disclose, teach or suggest, alone or in combination, each and every limitation of claim 21. Thus, claim 25 is allowable at least by virtue of its dependency on independent claim 21. Therefore, it is respectfully submitted that the unspecified rejection of claim 25 is improper at this time and the withdrawal of such rejection is respectfully requested.

X. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the

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Attorney Docket No.: 59482.000007

present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,
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